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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,191	06/13/2001	Ippo Aoki	209820US2S	4044

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EXAMINER	
ELAHEE, MD S	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/879,191	AOKI ET AL.	
	Examiner	Art Unit	
	Md S. Elahee	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 5, 8, 11, 14 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Regarding claim 1 the citation "a system ID identifying a provider to which the base station belongs" is not disclosed in the original specification. Regarding claims 5, 8, 11, 14 and 17 are rejected for the same reasons as discussed above with respect to claim 1.

Response to Amendment

3. This action is responsive to an amendment filed on 07/26/05. Claims 1-18 are pending.

Response to Arguments

4. Applicant's arguments with respect to claims 1-18 have been fully considered but they are not persuasive.

Regarding claims 1, 5, 8, 11 and 14, the Applicant argues on page 10, lines 19, 20 that "Hasegawa and Korpela focus on how to select a base station, and fail to show how to select a provider". The examiner disagrees with this argument. The applicant didn't claim selecting a provider. Since, the base station is offering announcement information such as message type,

location code, transmission power level as well as telecommunication service, it offers different types of service. Therefore, the base station is offering services inherently on behalf of a service provider. When identification identifies a particular base station it also identifies a provider to which the base station belongs (fig.6, 7, 20; col.2, lines 24-34, col.5, lines 51-67, col.6, lines 1-10, 22-46, col.35, lines 16-35). The Applicant further argues on page 11, line 23- page 12, line 3 that "In short, a mobile station of Hasegawa does not have a function of selecting a base station which it should be connected to, while a mobile station of Korpela has that function. In view of these conflicting teachings, it is respectfully submitted that the teachings of the cited references are not properly combinable, especially insofar as the motivation to combine apparently is only provided by Applicants' disclosure and not the references themselves". The examiner disagrees with this argument. The applicant didn't claim selecting a provider. Hasegawa suggests using memory [i.e., means] for storing information (see col.12, lines 53-64). Korpela uses memory [i.e., means] for storing information on whether each of the base station can offer a type of service (see fig.2; col.5, lines 33-60). Since, Korpela provides motivation for using memory then one ordinary skill in the art would have combined Hasegawa reference with Korpela reference so that the system can provide a particular base station for a particular service. Thus the rejection of the claims in view of Hasegawa and Korpela remain.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hasegawa (U.S. Patent No. 6,493,561) in view of Korpela et al. (U.S. Patent No. 6,167,283).

Regarding claims 1, 5, 8 and 14, Hasegawa teaches means for storing, for each geographical area, identification information [i.e., system Ids], priority data associated with each of the identification information [i.e., providers] and information indicating different types of service (fig.6, fig.7; col.2, lines 24-34, col.5, lines 51-67, col.6, lines 1-10, 22-46, col.12, lines 53-64, col.39, lines 16-26). (Note: Since, the base station is offering announcement information

such as message type, location code, transmission power level as well as telecommunication service, it offers different types of service)

However, it is not clear whether Hasegawa teaches means for storing information on whether each of the base station can offer a type of service. Korpela teaches memory [i.e., means] for storing information on whether each of the base station can offer a type of service (fig.2; col.5, lines 33-60). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hasegawa to incorporate means for storing information on whether each of the base station can offer a type of service as taught by Korpela. The motivation for the modification is to have doing so in order to provide the mobile user an option to select a particular base station for a particular service.

Hasegawa further teaches means for receiving one of the broadcasted identification information [i.e., system Ids] (col.6, lines 22-46, col.12, lines 53-64).

Hasegawa further teaches that first means for connecting [i.e., seizing], based on the stored priority data, one of the base stations operating in a geographical area for which the received identification information [i.e., system ID] is stored to set the apparatus in an idle state (fig.7; col.6, lines 22-46, col.12, lines 53-64, col.38, lines 24-44, 59-67, col.39, lines 1-26).

Hasegawa further teaches means for inputting a request for a desired type of service while the apparatus is in the idle state (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.38, lines 24-28, 59-67, col.39, lines 1-15).

Hasegawa further teaches means, in response to the request, for determining whether the provider of the base station offers the type of service in the geographical area based on the information stored for the geographical area (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.38, lines 24-28, 59-67, col.39, lines 1-26). (Note; provider is inherent)

Hasegawa further teaches reception level measuring unit [i.e., second means] for connecting [i.e., seizing], based on the stored priority data and the stored transmission power level or reception level [i.e., information], one of the base stations of the providers offering the desired type of service in the geographical area the determining means determines that the provider of the base station seized by the first means does not offer the desired type of service (fig.6, 7, 20, 31; col.5, lines 51-67, col.6, lines 1-10, 22-46, col.12, lines 53-64, col.14, lines 42-62, col.38, lines 24-44, 59-67, col.39, lines 1-26).

Regarding claims 2, 7, 10 and 18, Hasegawa teaches when the second means failed to seize the base station of the lowest priority, the receiving means newly receives a system ID and the second means seizes one of the base stations operating in a geographical area for which the newly received system ID is stored to set the apparatus in an idle state (col.38, lines 59-67, col.39, lines 1-3, 16-50).

Regarding claims 3, 6, 9 and 13, Hasegawa teaches that the storing means stores frequency data items associated with each of the system IDs, and the second means seizes a base station offering the desired type of service in accordance with the frequency data when the determining means determines that the base station seized by the first means does not offer the

desired type of service (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.12, lines 53-64, col.39, lines 16-26).

Regarding claims 4, 12 and 15, Hasegawa teaches means for transmitting the request to the base station seized by the second means (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.39, lines 16-26).

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claim 16 is rejected for the same reasons as discussed above with respect to claim 11.

Regarding claim 17 is rejected for the same reasons as discussed above with respect to claim 1.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blakeney, II et al. (U.S. Patent No. 6,466,802) teach Method and apparatus for performing preferred system selection.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.
MD SHAFIUL ALAM ELAHEE
October 16, 2005

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